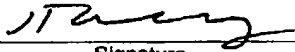


Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0851-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>NC 96,200</b>	
		Application Number <b>10/808264</b>	Filed <b>March 17, 2004</b>
		First Named Inventor <b>Teddy M Keller et al.</b>	
		Art Unit <b>1711</b>	Examiner <b>D. Truong</b>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/95)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>46,746</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 35%; text-align: center;"> <p> _____ Signature</p> <p><b>Joseph T. Grunkemeyer</b> _____ Typed or printed name</p> <p><b>(202) 404-1556</b> _____ Telephone number</p> <p><b>September 7, 2005</b> _____ Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.			

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office, facsimile no. , on the date shown below.

Dated: 9/7/05Signature: 

(Joseph T. Grunkemeyer)

PATENT APPLICATION  
Docket No.: NC 96,200

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of: Keller et al.

Serial No.: 10/808,264

Filed: 03/17/2004

For: OLIGOMERIC HYDROXY ARYLETHER PHTHALONITILES AND SYNTHESIS  
THEREOF

Examiner: Truong, Duc

Art Group Unit: 1711

Honorable Commissioner of Patents

PO Box 1450

Alexandria, VA 22313-1450

September 7, 2005

PRE-APPEAL REQUEST FOR REVIEW

Sir:

This Request is in response to the Final Rejection of 05/16/2005 and the Advisory Action of 08/23/2005. It is submitted with a Notice of Appeal and a Petition for Extension.

The Examiner has maintained the rejection of claims 1 and 2 under 35 U.S.C § 102(b) as allegedly anticipated by Keller et al. (US 4,259,471).

On 03/03/2005 Applicants submitted a declaration in response to the non-final rejection of 11/29/2004 to show that the Keller reference was non-enabling for the presently claimed compounds. In the final rejection, the Examiner stated that the declaration is not commensurate with the scope of the claims. It was not stated what part of the claim was not covered by the declaration. The declaration states that "the Ullmann ether synthesis referred to in the Keller reference (US Patent No. 4,259,471) cannot be used to make oligomeric or polymeric aryl ethers in high yield and high molecular weight." (Paragraph 3.) Thus, the scope of the declaration covers all polymeric aryl ethers, which is another term for polyaromatic ethers. Claim 1 recites

CERTIFICATE OF FACSIMILE TRANSMISSION

I certify that this correspondence is being facsimile transmitted to the US Patent and Trademark Office on the date shown below.

9/7/05  
Date

Joseph T. Grunkemeyer  
Joseph T. Grunkemeyer

Serial No.: 10/808,264

PATENT APPLICATION  
Docket No.: NC 96,200

certain polyaromatic ethers. Thus the declaration is at least commensurate with the scope of the claims, and the claims should be examined in light of the correct scope of the declaration.

The Examiner has maintained the rejection of claims 3 and 4 under 35 U.S.C § 102(b) as allegedly anticipated by Matzner et al. (US 5,084,530 or US 4,968,758).

In response to the non-final rejection, Applicants amended claim 3 (claim 4 dependent thereon) to change "n is an integer greater than or equal to 1" to "n is an integer greater than 1," thus canceling n=1. In both the final rejection and the advisory action, the Examiner stated that this amendment raises new issues requiring further consideration and search. However, since the amendment was made in response to the first office action, which was a non-final rejection, Applicants were entitled to make amendments that raise new issues. "The Applicant may amend: (A) before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 37 CFR 1.112." (MPEP 714, heading I.) The Examiner's objection appears to be based on 37 CFR 1.112, which does not apply to Applicants' amendment, as it was in response to a first office action. Further, there is no indication that entry of the amendment was denied. Thus, the amended limitation is present in the currently pending claims. As the amended limitation is clearly not anticipated by the reference (see response of 08/11/2005, page 4, lines 23-29), it appears that the amended limitation was not examined, and thus there is no basis for the rejection.

The Examiner has maintained the rejection of claims 4-7, 22-31, and 56-58 under 35 U.S.C § 103(a) as allegedly unpatentable over Matzner et al. (US 5,084,530 or US 4,968,758).

As to claims 4-7, the argument above regarding the amendment to claim 3 applies.

As to claims 22-31, and 56-58, the Examiner again stated in the final rejection that the amendment of 03/03/2005 in response to the non-final rejection raises new issues requiring further consideration and search. The argument above regarding the amendment to claim 3 applies.

Further, these claims are process claims. Applicants have argued that the recited process steps are not disclosed in the references because the processes of the references do not use the reactants recited in the claims as amended. (response of 08/11/2005, page 5, line 25-page 6, line 25). This argument has not been addressed by the Examiner, presumably because the

Serial No.: 10/808,264

PATENT APPLICATION  
Docket No.: NC 96,200

amendment of 03/03/2005 has not been considered.

The Examiner stated in the final rejection that "Applicant's arguments are based on the presence of a copper compound when reacting the dihydroxyaromatic with a dihaloaromatic component." No such argument has been made by Applicants. Applicants have argued specific copper compounds in reference to dependent claims, but have not argued that copper compounds in general were not disclosed.

In view of the foregoing, it is submitted that the application is now in condition for allowance.

In the event that a fee is required, please charge the fee to Deposit Account No. 50-0281, and in the event that there is a credit due, please credit Deposit Account No. 50-0281.

Respectfully submitted,



Joseph T. Grunkemeyer  
Reg. No. 46,746  
Phone No. 202-404-1556  
Office of the Associate Counsel  
(Patents), Code 1008.2  
Naval Research Laboratory  
4555 Overlook Ave, SW  
Washington, DC 20375-5325